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APPLICATION NO.	FILING DATE.	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,908

09/30/2003

Evon Llewellyn Crooks

030627/267420

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01/17/2007

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EXAMINER

LAZORCIK, JASON L

ART UNIT

PAPER NUMBER

1731

MAIL DATE

DELIVERY MODE

01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/674,908	<b>Applicant(s)</b> CROOKS ET AL.	
	<b>Examiner</b> Jason L. Lazorcik	<b>Art Unit</b> 1731	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

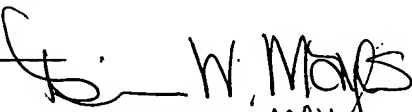
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Attached.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_

  
**DIONNE A. WALLS**  
**PRIMARY EXAMINER**

Regarding the rejection of Claims 1, 3-15, and 17 through 20 under 35 USC 103(a) over Counts in view of Zhuang, Yang and Keith, Applicant acknowledges that Yang and Zhuang provide motivation to modify the filter structure as laid out in the Counts reference. However, Applicant argues that "there is nothing suggesting the specific arrangement of elements relied upon by the Examiner to arrive at the presently-claimed invention." Applicant further asserts that the Examiner relied upon improper hindsight reasoning in arriving at the claimed cigarette structure and that "there are no specific teachings as to how the various filter components should be arranged in an advantageous manner."

This argument has been fully considered and has been found to be unpersuasive. Applicant points to at least four structures which could be arrived at through the combination of the filter sub-elements disclosed by the cited prior art. The Examiner is agreement that the Zhuang filter could be substituted for the section of the tubular free flow filter (102) in a location a) proximal to the tobacco rod, b) distal from the tobacco rod, or c) at some intermediate location there between. That said, no motivation has been found for the arrangement suggested by Applicant wherein the Yang particles are located "in the interior space within the Zhuang filter component".

Accepting the remaining indicated structural arrangements as obvious variants in the combination of the cited prior art, the question then arises regarding whether Applicants structure provides any materially unexpected results over the other geometries to such an extent to render said arrangement patentably distinct over the

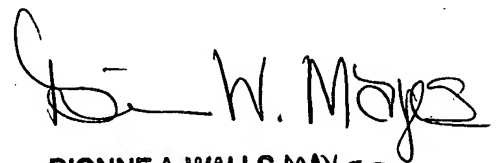
Art Unit: 1731

other possible arrangements. It is the Examiners position that no substantially unexpected results have thus been presented and that one of ordinary skill in the art in possession of the Counts, Zhuang, and Yang references would have reasonably found motivation to combine the elements of the filter in the claimed arrangement. Applicant is directed to *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). It is therefore the Examiners position that the claimed cigarette filter structure would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention in possession of the indicated prior art references.

Additionally, Applicant argues against the motivation to combine the teachings of Keith with Zhuang by specifically since the Zhuang patent indicates the use of common fibrous tow are "not optimal for the removal of gas-phase constituents from tobacco smoke". While a the Applicants argument regarding the selection of optimal materials of construction for the filter may or may not bear merit, the selection of fibrous tow would be have been an obvious alternative to one of ordinary skill in the art at the time of the invention. As explicitly set forth in the prior Office Action, "given the widespread utilization of cellular acetate tow and activated carbon as constituents in cigarette filters, it would have been obvious to one of ordinary skill in the art at the time of the invention

Art Unit: 1731

to modify the MCF filter to utilize these materials of construction. Specifically, since fibrous tow is BY FAR THE MOST COMMON FILTERING AGENT it would have been obvious to fabricate either of the longitudinally extending sections of fibrous material or the semi-permeable barrier out of cellulose acetate tow or "a fibrous tow material" either alone or in combination with granular activated carbon". Further precedent has be set forth in the case law and can be found with reference to In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994), wherein is set forth that "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use."



DIONNE A. WALLS MAYES  
PRIMARY EXAMINER